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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,530	06/15/2001	Derrick A. Richardson	485772003600	9930
7590	11/01/2005			
Rimas Lukas				
P.O. Box 3295				
Half Moon Bay, CA 94019				
			EXAMINER	
			LEWIS, PATRICK T	
		ART UNIT		PAPER NUMBER
		1623		

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/882,530	RICHARDSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Patrick T. Lewis	1623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23,27,34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20,23,27,34 and 35 is/are rejected.
- 7) ☒ Claim(s) 21 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Applicant's Response Dated August 19, 2005***

1. Claims 1-23, 27, and 34-35 are pending. An action on the merits of claims 1-23, 27, and 34-35 is contained herein below.
2. The rejection of claims 1-3, 5-7, 12-13, 15, 19, 23, 27 and 34-35 under 35 U.S.C. 102(b) as being anticipated by Forsythe, Jr. et al. US 4,214,993 (Forsythe) is maintained for the reasons of record set forth in the Office Action dated February 8, 2005.
3. The rejection of claims 4, 10-11, 14, 16-18 and 20 under 35 U.S.C. 103(a) as being unpatentable over Forsythe in combination with BIO-RAD, Life Science Research Products Catalog (1993), pages 57 and 60-63 (BIO-RAD) is maintained for the reasons of record set forth in the Office Action dated February 8, 2005.

### ***Rejections of Record Set Forth in the Office Action Dated February 8, 2005***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1-3, 5-7, 12-13, 15, 19, 23, 27, and 34-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Forsythe, Jr. et al. US 4,214,993 (Forsythe).

Applicant's arguments filed August 19, 2005 have been fully considered but they are not persuasive. Applicant argues that: 1) the examiner has not given patentable weight to all of the claim limitations (for example the phrase "adapted to fit securely"), 2)

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Forsythe does not teach a filter column having a body with bearing surfaces adapted to seat on at least two collection tubes, and 3) Forsythe does not teach a filter column adapted to seat on collection tubes having differently-sized openings.

As set forth by the examiner in the Office Action dated February 8, 2005, Forsythe discloses all of the structural limitations of the instantly claimed filter column. Applicant's attention is directed to the middle component shown Fig. 2 of Forsythe. The surface directly below (underneath) the rim is one bearing surface. The stem (12 shown in Fig. 1) is directly below the rim and has a smaller diameter than the rim. The surface directly below (underneath) the stem is a second bearing surface. The extraction cartridge (16 shown in Figs. 1 and 2) is directly below the stem and has a smaller diameter than the rim. The tip is directly below the extraction cartridge (Fig. 1) and has a smaller diameter than the extraction cartridge. The tapered surface directly below the extraction cartridge is a third bearing surface. The portion of the column directly below each of these bearing surfaces has a different diameter and is therefor capable of accommodating three different collecting tubes of appropriate diameter. The argument that Forsythe only demonstrates the use of one collecting tube is not sufficient to overcome the instant rejection. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function.

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6. Claims 4, 10-11, 14, 16-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forsythe, Jr. et al. US 4,214,993 (Forsythe) in combination with BIO-RAD, Life Science Research Products Catalog (1993), pages 57 and 60-63 (BIO-RAD).

Applicant's arguments filed August 19, 2005 have been fully considered but they are not persuasive. Applicant argues that: 1) the examiner has not given patentable weight to all of the claim limitations (for example the phrase "adapted to fit securely"), 2) Forsythe does not teach a filter column having a body with bearing surfaces adapted to seat on at least two collection tubes, and 3) Forsythe does not teach a filter column adapted to seat on collection tubes having differently-sized openings.

As set forth by the examiner in the Office Action dated February 8, 2005, Forsythe discloses all of the structural limitations of the instantly claimed filter column. Applicant's attention is directed to the middle component shown Fig. 2 of Forsythe. The surface directly below (underneath) the rim is one bearing surface. The stem (12 shown in Fig. 1) is directly below the rim and has a smaller diameter than the rim. The surface directly below (underneath) the stem is a second bearing surface. The extraction cartridge (16 shown in Figs. 1 and 2) is directly below the stem and has a smaller diameter than the rim. The tip is directly below the extraction cartridge (Fig. 1) and has a smaller diameter than the extraction cartridge. The tapered surface directly below the extraction cartridge is a third bearing surface. The portion of the column directly below each of these bearing surfaces has a different diameter and is therefore capable of accommodating three different collecting tubes of appropriate diameter. The argument that Forsythe only demonstrates the use of one collecting tube is not sufficient to

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overcome the instant rejection. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function.

Applicant's remarks in regards to dependent claims 10-11, 14, 16-18 and 20 have been noted; however, the differences between Forsythe and the instantly claimed filter column are seen as one of design choice. BIO-RAD teaches columns within applicant's specified dimensions.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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9. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forsythe, Jr. et al. US 4,214,993 (Forsythe) in combination with BIO-RAD, Life Science Research Products Catalog (1993), pages 57 and 60-63 (BIO-RAD) as applied to claims 4, 10-11, 14, 16-18 and 20 above, and further in view of Lyman et al. US 4,683,058 (Lyman).

Claims 8-9 further require the presence of vents.

Lyman teaches the use of vent in connection with centrifuge tubes (column 4). The filter tube includes a groove in the outer wall of the first cylindrical portion and extending into the filter flange which serves as a venting means to allow air to escape from the centrifuge tube as the permeable material filters through the filter tube.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include vents in the body of the filter column. As taught by Lyman, the vents allow for the escape of air while using the centrifuge.

### ***Conclusion***

10. Claims 1-23, 27, and 34-35 are pending. Claims 1-20, 23, 27 and 34-35 are rejected. Claims 21-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. No claims are allowed.

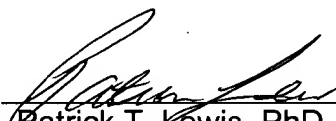
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**Contacts**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick T. Lewis whose telephone number is 571-272-0655. The examiner can normally be reached on Monday - Friday 10 am to 3 pm (Maxi Flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Patrick T. Lewis, PhD  
Examiner  
Art Unit 1623

ptl